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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,483	05/01/2001	Laurent Chambard	2000M005	7731

7590

03.07.2002

Infineum USA L.P.
Law Department
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Linden, NJ 07036-0710

EXAMINER

MCAVOY, ELLEN M

ART UNIT	PAPER NUMBER
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1764

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DATE MAILED: 03/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/846,483

Applicant(s)

CHAMBARD ET AL.

Examiner

Ellen M McAvoy

Art Unit

1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 1, 2001 (preliminary amendment).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 and 10-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clarke (4,283,294), Brook(3,625,893) and Fujitsu et al (6,114,288), considered separately.

Clarke discloses lubricating oil compositions suitable for use in marine diesel engines comprising 60 to 85 parts by weight of lubricating oil, 15 to 30 parts by weight of a mixture of more than 50 weight % of a Group IIa metal overbased detergent and up to 50 weight % of a Group Ia metal overbased detergent and 0.2 to 5 parts by weight of an antioxidant, provided the molecular weight ratio of the overbased detergent mixture to antioxidant lies between 7.5:1 and 50:1. The lubricating oil may be an animal, vegetable, mineral oil or synthetic oil and is preferably a hydrocarbon oil such as mineral oil. See column 1, lines 17-44. Suitable overbased detergent additives include phenates, sulphonates, and salicylates. See column 1, line 67 to column 2. See especially lines 43-55 of column 2, where overbased calcium salicylate is taught. Examples of suitable antioxidants include alkylated phenols, organic amines, organic sulphur

compounds and metal thiophosphates. See column 3, lines 52-54. Zinc dialkyldithiophosphate is taught as suitable. See column 4, lines 3-6. The examiner is of the position that the oil compositions of Clarke meet the limitations of the claims when the detergent component is an overbased salicylate.

Brook et al ["Brook"] disclose lubricating oil compositions suitable for use in large marine diesel propulsion engines which comprise a hydrocarbon lubricating oil such as mineral oil and a mixture of highly basic oil-soluble Group II metal salts of aromatic carboxylic acids and highly basic oil-soluble Group II metal salts of naphthenic acids. See column 1, lines 53-75. Suitable aromatic carboxylic acids include benzoic, salicylic, resorcylic, anthranilic and naphthoic acids. See column 2, lines 1-8. Brook allows for the addition of other additives such as metal thiophosphates such as zinc dithiophosphates. See column 2, lines 52-63.

Fujitsu et al ["Fujitsu"] disclose lubricating oil compositions for internal combustion engines comprising a base lubricating oil, (1) a zinc dithiophosphate and (2) a metallic detergent chosen from calcium alkylsalicylate and a mixture of calcium alkylsalicylate and magnesium alkylsalicylate and, optionally, (3) a friction modifier. The examples set forth in Table 2 comprise compositions with metallic detergent A, a calcium salicylate having a TBN of 150 mg KOH/g; metallic detergent B, a calcium salicylate having a TBN of 80 mg KOH/g; and metallic detergent C, a magnesium salicylate having a TBN of 340 KOH/g. See examples 1 and 2 which also comprise wear resistance agent A which is a secondary zinc dithiophosphate. The examiner is of the position that these examples meet the limitations of the claims.

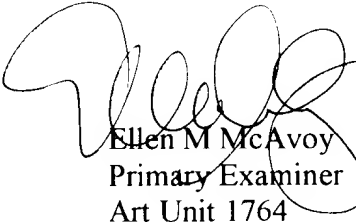
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M McAvoy whose telephone number is (703) 308-2510. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marian Knode can be reached on (703) 308-4311. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Ellen M McAvoy
Primary Examiner
Art Unit 1764

EMcAvoy
March 5, 2002